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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,924	05/04/2001	Fred E. Regnier	290.0001 0101	8955

26813 7590 10/22/2002

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EXAMINER
TRAN, MY CHAUT

ART UNIT	PAPER NUMBER
1639	

DATE MAILED: 10/22/2002 12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/849,924	REGNIER ET AL.	
	Examiner	Art Unit	
	My-Chau T. Tran	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 August 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-99 is/are pending in the application.
- 4a) Of the above claim(s) 33-99 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 October 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7 & 11</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I (Claims 1-32) in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the search for all groups would not be burdensome.

This is not found persuasive because these inventions are distinct for the reasons given in Paper No. 8 (e.g. each group have different structural format, operations (method steps), or function) and the searches required are not co-extensive thus requiring a burdensome search. Additionally, different patentability considerations are involved for each group. For example, a patentability determination for Group III would involve a determination of the patentability of the method for determining whether a protein is present in one sample but not in another sample while patentability determination for Group V would involve a consideration of the patentability of the method for quantifying a peptide. These considerations are very different in nature.

Therefore the search and examination of all three inventions would be burdensome. The requirement is still deemed proper and is therefore made FINAL.

2. Claims 33-99 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

3. This application contains claims 33-99 are drawn to an invention nonelected with traverse in Paper No. 10. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) The term “isotopic variant” of Claim 1, 4, 5, and 6 is vague and indefinite because it is unclear from what bases is the variation derived from. Is the difference within a particular isotopic species? Or is different isotopic species?

b) It is unclear what is meant by the phrase “normalized isotope ratio” of Claim 1, 3, 5, and 6 because it is unclear comparing to what isotopic ratio is it being “normalized”. It is the first sample? Or the second sample? Or a known sample?

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(c) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by Chen et al.

(*Anal. Chem.*, 2000, 72(6):1134-1143).

Chen et al. disclosed a method of generating acute and efficient protein identification by mass spectrometry (Abstract). Selected amino acids are labeled with $^{13}\text{C}/^{15}\text{N}^2\text{H}$ and incorporated into proteins in a sequence-specific manner during cell culturing. The method steps for mass tagging of complex mixture include labeling the amino acids of two types of protein vectors in the cell. Isolating the vectors by gel filtration into fractions. The fractions are then treated with trypsin and then MALDI MS analysis (pg. 1136, left column, 4th paragraph; pg. 1139, right column, 2nd and 3rd paragraph). The method of Chen et al. anticipates the claimed invention.

8. Claims 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Geng et al.

(*Journal of Chromatography A*, 2000, 870(1-2):295-313).

Geng et al. disclosed a method of protein identification by mass spectrometry (Abstract). The complex mixture of proteins was digested with trypsin and the peptides are fractionated by affinity chromatography. The peptides are subjected to matrix-assisted laser desorption

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ionization mass spectrometry. The method steps include selecting a sample from a particular compartment of organelle (pg. 299, left column, second paragraph to right column). All the proteins in the sample are reduced and alkylated and the polypeptides are then digested by tryptic digestion. The sample is then fractionated by affinity chromatography and then analyzed by mass spectrometry. The method of Geng et al. anticipates the claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

mct
October 21, 2002



ANDREW WANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600